

REMARKS

In response to the Office Action dated August 14, 2007, Applicant respectfully requests reconsideration based on the above claim amendments and the following remarks.

Status of the Claims

Claims 1, 2, 4, 6-16, 19-30, 32, 34-44, 47-58, 60, 62-72, and 75-85 are now pending in the present application following the foregoing amendments. Claims 1, 2, 4, 6-16, 19-30, 32, 34-44, 47-58, 60, 62-72, and 75-85 stand rejected under Section 103 as being unpatentable over Items U1-X7 cited in the PTO-892 (collectively referred to herein as "Superpages") in view of U.S. Patent No. 6,374,241 to Lamburt et al. (Lamburt).

The Rejections under Section 103

Applicant hereby incorporates by reference Applicant's arguments as set forth in Applicant's Response dated May 10, 2007.

Claim 1 has been amended to more clearly and explicitly recite, *inter alia*:

receiving at least one request from the customer via the Web site to include at least one feature in the listing of the business in the business directory, including receiving an enhancement request from the customer via the Web site to include in the listing of the business in the business directory at least one optional listing enhancement from the list of available optional listing enhancements, whereby the customer configures a customized business listing;

generating a customized price quote **for the particular customized business listing configured by the customer**, wherein the step of generating the customized price quote includes calculating the customized price quote based on **the particular features requested by the customer** to be included in the customized business listing;

displaying the customized price quote for the customized business listing at the Web site to the customer; and

receiving an order request from the customer via the Web site to place an order for the **customized** business listing in the business directory, including the at least one optional listing enhancement requested by the customer.

Applicant respectfully submits that Claim 1 as now amended clearly obviates the concern set forth on pages 3-4 of the Action as to the scope of Claim 1.

In the Response to Arguments section, the Action contends:

Applicant argues that elements are not present in the prior art by citing specific examples of the disclosure in Superpages, but the elements at issue were cited in the previous office action as having been present in Lambert. Applicant's argument that an element is not present in Lambert because it is not explicitly disclosed in the webpages cited as Superpages is not persuasive. As noted in the previous office action, the disclosure of Lambert is significantly more detailed than that of Superpages. The reason for citing Lambert was due to its more comprehensive disclosure. It is noted as well that applicant directs remarks only to figures 16-17 of the Lambert reference although a larger portion of the reference was cited. In addition, although the Examiner cites particular pages and paragraphs or columns and line numbers in the references as applied to the claims for the convenience of the applicant, other passages and figures may apply as well. Although the specific citations are representative of the teachings in the art and are applied to the specific limitations within the claims, it is respectfully requested that in preparing responses that applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Applicant has reviewed the entirety of Lambert and has made a good faith effort to apply the cited art to the claimed inventions in the manner suggested by the Action. However, Applicant respectfully submits that the cited art, particularly Lambert, do not provide the purported disclosure. Lambert may be more detailed or provide more comprehensive disclosure than Superpages in some respects, but such disclosure of Lambert is generally only comprehensive with respect to aspects of the Lambert system that are not relevant to the subject matter of Claim 1. Of the 71 figures of Lambert, only **Figures 16-22** appear to relate to the rejection set forth in the Action. Applicant has not argued that "an element is not present in Lambert because it is not explicitly disclosed in the webpages cited as Superpages". To the contrary, Applicant has simply noted that not only are certain claimed elements not disclosed by Lambert, those elements are not disclosed by Superpages either and, moreover, Superpages itself demonstrates that one cannot assume that the claimed

aspects are somehow inherent in the system Lamburt does disclose. Should the Examiner maintain the rejections over Lamburt in view of Superpages, Applicant requests that the Examiner provide more specific identification of the portions of Lamburt believed to disclose the claimed invention (and, to the extent is it not self-evident, how those portions are believed to apply).

The foregoing notwithstanding, Applicant notes that, in Applicant's previous Response, Applicant in some cases did not fully or accurately reference the figures of Lamburt; namely, in some instances, **Figures 16 and 17** were cited where **Figures 19 and 20** were being discussed. For this reason, Applicant repeats these arguments below with corrected figure references.

Applicant respectfully submits that Lamburt does not in fact teach the recited steps as claimed. The Web pages illustrated in **Figures 16-17** of Lamburt only provide descriptions of enhancements and "click here" hotlinks "For more information and samples". The web pages illustrated in **Figures 19-20** of Lamburt also provide "Order" hotlinks, but Lamburt provides no indication as to what occurs when the "Order" links are selected.

While Lamburt apparently displays prices for certain features, there is no indication that Lamburt permits a customer to configure a customized business listing and receives an order request from the customer via the Web site to place an order for the customized business listing in the business directory as claimed. The claimed aspects are not necessarily evidenced by the provision of the "Order" hotlinks. For example, Superpages Items U3 and W4 similarly list "Platinum Link", "Gold Link", "Silver Link", "Basic Link", and various web site options with purported prices for each, but then provide text/links "Click here for Options to Order and to contact us for pricing" (emphasis added). Item U2 (the apparent main Web page for the "Advertise with Us" menu option) recites "Options to Order Now Include: A. Online Inquiry... B. Phone... C. Contact Your Local Verizon Sales Rep...." (See Item U2 at page 2). It appears that selecting "Click here" in Item U3 or Item W4 provides this options listing and, based on the map listed at the top of Item V3, it appears that the Web page of Item V3 is provided in response to selection of the "Online Inquiry" option. Item V3, however, only provides a form for the customer to fill in and submit to Verizon to request that Verizon call the customer or mail the customer more information. Thus, Superpages

does not appear to contemplate enabling the customer to order a listing including such an optional hotlink or web site enhancement at the Web site. Likewise, if in fact Superpages and Lamburt are closely related as the Action contends, it seems likely that the “Order” link of **Figures 19-20** of Lamburt would provide only the same limited options as the “Click here” links of Item U3 of Superpages and would not enable a customer to order the enhanced listing via the Web site. Traditionally, listing enhancements have been offered to customers through direct interactions or negotiations with sales representatives of the business directory offeror. Thus, it may be expected that the only ordering options for listing enhancements would require interfacing with a sales representative.

Moreover, there is no indication that Lamburt calculates a customized price quote based on features to be included in the customer’s customized business listing and displays the customized price quote at the Web site as claimed. No calculation of a price quote is evident from Superpages or Lamburt. The only pricing information displayed in **Figures 16-17** or **19-20** of Lamburt is for a given feature or a Web site¹, not a customized price quote that is calculated for the particular business listing configured and ordered by the customer. The Action does not appear to address this deficiency of Superpages and it does not appear that Lamburt in any manner cures the deficiency.

In view of the foregoing, Applicant respectfully submits that Claim 1 as amended is allowable over the cited art. Claims 2, 4, 6-16, 19-28, and 85 depend from Claim 1 as amended and are therefore allowable as well for at least these reasons.

Claim 29 (system for receiving an order for a listing of a business in a business directory) and Claim 57 (computer program product for receiving an order for a listing of a business in a business directory) have been amended similarly to Claim 1 and are distinguishable from the cited art for the reasons set forth above. Claims 30, 32, 34-44, and 47-56 depend from Claim 29 and Claims 58, 60, 62-72, and 75-84 depend from Claim 57, respectively, and these claims are therefore allowable as well for at least these reasons.

¹ In fact, in view of Items U3 and W4 of Superpages (which state “Click here... to contact us for pricing information”), it is not clear whether the listed prices are firm prices or merely illustrative.

At least certain of the dependent claims are further patentably distinguishable from the cited art. Claim 16 as amended depends from Claim 1 and further recites "displaying at the Web site a solicitation for billing information from the customer; and receiving billing information from the customer via the Web site." The Action contends that Item V3 discloses this step. Responsive to Applicant's Response dated May 10, 2007, the Action contends:

The prior art displays a solicitation for and receiving of information identifying the customer. Applicant argues that the information is merely contact information rather than billing information. A comparison of the information fields in the reference (see at least V3 p. 1) with those in the present application's Figure 11 shows that the fields are virtually identical. The information in the prior art would also ultimately be used for billing purposes. Applicant argues that the two types of information "are not necessarily the same." The continuing discussion regarding whether the information is exactly the same or slightly different makes very clear that the essential nature of the information has no functional bearing on the steps performed in the method. The customer's identifying information, whether it is called contact information or billing information, is descriptive material and is not functionally involved in the recited steps of the method. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106).

Applicant argues that the difference between the two types of information "has a direct and important functional bearing on the steps performed." A reading of the claims shows otherwise. The relevant features claimed are, essentially, displaying a solicitation for information, and receiving the information. These functions are not influenced by the description of the information.

Applicants respectfully submit that the Examiner has misapplied the law with regard to nonfunctional descriptive material. Notably, *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), is not cited in MPEP Section 2106 for the principle stated in the Action, but rather is cited in the instruction:

When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory and should be rejected under 35 U.S.C. 101. In addition, USPTO personnel should inquire whether there should be a rejection under 35 U.S.C. 102 or 103. USPTO personnel should determine whether the claimed nonfunctional descriptive material be given patentable weight. USPTO personnel must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983). USPTO personnel may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384, 217 USPQ at 403; see also *Diehr*, 450 U.S. at 191, 209 USPQ at 10. However, USPTO personnel need not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004).

MPEP Section 2106.01. In *In re Gulack*, the Federal Circuit held that there did exist a functional relationship between the printed matter and the substrate of the appealed claims. A copy of *In re Gulack* is enclosed for the Examiner's reference.

As best understood, the Action concludes that the solicited and received information of Claim 16 is nonfunctional because "[t]he relevant features claimed are, essentially, displaying a solicitation for information, and receiving the information. These functions are not influenced by the description of the information." Action at p. 5. The Action has thereby improperly ignored explicit recitations of Claim 16.

Furthermore, in the present case, the subject matter of Claim 16 in question is not merely descriptive material (whether functional or nonfunctional) that is "recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal." MPEP Section 2106.01. Claim 16 recites particular method steps involving two-way interaction with the customer. Claim 16 does not claim the descriptive material *per se*. Accordingly, it is unclear whether the distinction between functional and nonfunctional descriptive material as discussed in MPEP Section 2106 and *In re Gulack* is even applicable in the context of Claim 16.

The function of the recited steps of Claim 16 is to solicit and receive the specified special information, namely, billing information. Therefore, the specified information is

integral to the function of the claim steps of Claim 16 and the claimed method as a whole. This can be demonstrated by considering alternative steps wherein the method includes soliciting and receiving the customer's date of birth instead of the customer's billing information. Such alternative steps would in no manner facilitate the important function of providing the business directory offeror with the information needed to demand and receive payment. More broadly, the billing information solicited and received in accordance with Claim 16 can enable a customer to fully or more fully configure and order a business directory listing without the need for any follow up by a representative of the business directory offeror. Hence, the function of the steps of Claim 16 is not merely influenced by the type of information involved; the type of information in fact defines the purpose of those steps.

Moreover, at least certain of the substantive contentions in support of the rejection of Claim 16 are in error. The contention that the fields of Item V3 of Superpages and **Figure 11** of Applicant's specification "are virtually identical" is incorrect. The respective fields differ in at least one critical respect – the Superpages fields receive contact information and Applicant's fields receive billing information. This distinction is further evidenced by the conspicuous warning on the Webpage of Applicant's **Figure 11**, "Note: If billing information differs from listing information, overwrite the information in the fields below." While the information provided by a customer in the fields of Item V3 may in some cases also happen to also be the customer's desired billing information, such occurrence will be, at best, random.

The Action's contention that "[t]he information in the prior art would also ultimately be used for billing purposes" is entirely unsupported conjecture and probably untrue in many cases. Many customers use distinctly different addresses (which may correspond to distinctly different personnel and/or departments) for, on the one hand, investigating or procuring products or services such as a business directory listing and, on the other hand, for receiving and processing bills from vendors such as a business directory provider. The person who provides her contact information (via Superpages Web page V3) merely for the purpose of inquiring about or subsequently ordering a business directory listing likely does not want or expect the periodic invoice to be directed to her attention. If, in fact, the business directory

offeror sent invoices to mere contact addresses as a matter of course, the business directory offeror would likely experience frequent customer requests to change billing addresses (and, probably, frequent complaints).

Claims 24, 44, 52, 72 and 80 include the same or similar recitations as Claim 16 and are therefore further distinguishable from the cited art for these reasons as well.

In re: Wealthy Desai
Serial No.: 10/624,325
Filed: July 22, 2003
Page 27 of 27

CONCLUSION

Applicant respectfully submits that this application is now in condition for allowance, which action is requested. Should the Examiner have any matters outstanding of resolution, he is encouraged to telephone the undersigned at 919-854-1400 for expeditious handling.

Respectfully submitted,



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Katie Wu
Date of Signature: October 19, 2007